

PATENT
Customer No. 22,852
Attorney Docket No. 08702.0005-00000

REMARKS

Applicants herein cancel claims 26-56 without prejudice, and add new claims 57-80. Applicants submit that the amendments do not introduce new matter. Specifically, the new claims are supported in the specification in Example IV, in Figure 3, in the claims as filed, and at page 5, lines 30-32, page 26, lines 10-33, and page 34, lines 5-17, for example.

The amended claims are submitted in response to a telephonic interview with the Examiner to determine whether the amended claims presented above are allowable. Applicants thank the Examiner for discussing the new claims.

The previous claims were rejected under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter which was not described and/or enabled. Without acquiescing in the prior grounds for rejection, the previously pending claims are herein cancelled without prejudice. Applicants submit that new claims 57-80 are adequately described and enabled. The Examiner has noted that methods of identifying a compound which inhibits the activity of a SLIC-1 protein are free of the art. (Office Action of June 9, 2003 at paragraph 8.)

Claims are adequately described when one skilled in the art, reading the specification, would conclude that the inventors were in possession of the claimed invention when the application was filed. The present methods recite methods for identifying a compound that inhibits or increases the binding of a SLIC-1 protein to PSGL-1, wherein the SLIC-1 protein has amino acids 1-226 of SEQ ID NO:2, 1-316 of SEQ ID NO:2, or fragments thereof having PSGL-1 binding activity. This SLIC-1 protein may optionally also have at least one heterologous sequence. (See page 5, lines 30-

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32.) The specification discloses the actual reduction to practice of several SLIC-1 proteins, and demonstrates that amino acids 1-226 and 1-316 of SEQ ID NO:2 are capable of binding to PSGL-1. (See Figure 3.) The specification also discloses the use of biologically active portions of SLIC-1 alone or in combination with a heterologous sequence. (See, for example, page 5, lines 19-21 and page 26, lines 10-33, page 34, lines 5-17, and page 73, line 29 to page 74, line 1.) Thus, structural and functional elements of SLIC-1 that support the binding of a SLIC-1 protein to PSGL-1 are disclosed in the specification and recited in the pending claims. Applicants were therefore in possession of the claimed methods at the time the application was filed.

Further, the test of enablement is whether the disclosure allows one skilled in the art to practice the claimed invention without undue experimentation. The Examiner states that the specification is enabling for methods using "SLIC-1 set forth in SEQ ID NOS:1 and 2," but does not reasonably provide enablement for methods using any "SLIC-1 protein or polypeptide." The Examiner additionally objects to methods of using SLIC-1 variants having "SLIC-1 activity." As amended, the claims recite use of a SLIC-1 protein consisting of a SLIC-1 moiety and an optional heterologous amino acid sequence, and methods of involving the "binding of . . . SLIC-1 protein to PSGL-1." Applicants respectfully assert that the disclosure enables the amended claims, for example, methods of determining protein-protein binding are described at pages 47-52, and in Example IV. The binding of a SLIC-1 protein having amino acids 1-226 or 1-316 of SEQ ID NO:2 to PSGL-1 is shown in the co-immunoprecipitation assay of Figure 3. (See also, page 75, lines 7-12.) Figure 3 also demonstrates that amino acids 1-88 or 1-160 of SEQ ID NO:2 fail to associate with PSGL-1 in this assay. Given the extensive

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disclosure of exemplary SLIC-1 fragments, see, e.g., page 24, lines 13-26, one skilled in the art could make and use the full scope of the claimed genus of SLIC-1 moieties that have PSGL-1 binding. Thus, one skilled in the art would readily be able to make the SLIC-1 fragments that have PSGL-1 binding activity and use them in the claimed method with only routine experimentation.

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: April 20, 2004

By: 

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